Goodyear Tire & Rubber Co & Anor v Silverstone Tire & Rubber Co Sdn Bhd

HIGH COURT (KUALA LUMPUR) — CIVIL SUIT NO D5-22-660-1993
ABDUL MALEK J
22 NOVEMBER 1993

Copyright *— Infringement — Whether copyright protected the idea of the function of the tyre*

Trademarks *— Infringement and passing-off — Whether get up of tyres distinctive of plaintiffs — Whether plaintiffs had established substantial reputation and goodwill*

The first plaintiff was the manufacturer and seller of Aquatred typres which its team of experts designed and invented. The second plaintiff was the Malaysian importer and seller of Aquatred tyres. The plaintiffs brought this action for alleged infringement of copyright and passing-off. The plaintiffs contended that the Aquatred tyres have a unique and distinctive get up, namely, the centre groove, and that the defendant's Aquagrip tyres were reproduced either from the plaintiff's drawings or from the Aquatred tyres by reverse engineering. With regard to passing-off, the plaintiffs argued that they had acquired a substantial degree of reputation and goodwill in the Aquatred tyres in that the get up was distinctive of the plaintiffs by reason of extensive use, sales and promotion in the United States and Malaysia. The defendant contended that the plaintiffs were seeking to protect the function of the Aquatred tyres which were not protected by copyright law.

Held, dismissing the plaintiffs' application:

(1) Copyright law is not concerned with the reproduction of ideas, but with the reproduction of the form in which ideas are expressed. The plaintiffs were seeking to protect the idea of the function of the tyre and not its artistic value. Here, the evidence was not clear as to the authorship of the drawings. Doubts were also raised as to whether the drawings were original.

(2) The plaintiffs had not shown that the get up was distinctive of the plaintiffs to the exclusion of all others and that the public would recognize the tyre by its get up and not its name. Since all tyres would have the brand names and tyre names imprinted on them, no confusion would arise as customers would, in practice, have chosen the brand first before deciding on the type of tyre they wanted.

(3) Since the Aquatre tyres had been in the Malaysian market for only eight months when this action was brought, it was too short a time to establish any goodwill and reputation.

(4) Although there was a serious question to be tried, the balance of convenience laid in favour of the defendant. To grant the injunction would give the plaintiffs an unfair monopoly of the tyre market for the aqua design.

[Bahasa Malaysia summary

Plaintif pertama merupakan pengeluar dan penjual tayar Aquatred yang direka dan dicipta oleh kumpulan pakar mereka. Plaintif kedua merupakan pengimpot dan penjual tayar Aquatred di Malaysia. Plaintif telah membawa tindakan ini untuk pelanggaran hakcipta dan kelirupaan. Plaintif mengatakan bahawa tayar Aquatred mempunyai caragaya yang unik dan tersendiri, iaitu alur tengahnya, dan bahawa tayar Aquagrip defendan telah ditiru daripada lukisan plaintif pertama ataupun daripada tayar Aquatred dengan cara 'reverse engineering'. Mengenai kelirupaan, plaintif berhujah bahawa mereka telah memperolehi reputasi dan nama baik yang substansial dalam tayar Aquatred, iaitu caragayanya adalah tersendiri kepada plaintif disebabkan penggunaan, penjualan dan promosi yang luas di Amerika Syarikat dan Malaysia. Defendan menegaskan bahawa plaintif ingin melindungi fungsi tayar Aquatred yang tidak dilindungi oleh undang-undang hakcipta.

Diputuskan, menolak permohonan plaintif:

(1) Undang-undang hakcipta tidak berkaitan dengan tiruan idea tetapi dengan tiruan bentuk idea yang dinyatakan. Plaintif menuntut perlindungan idea fungsi tayar dan bukannya nilai ciptaan seninya. Di sini keterangan yang diberikan adalah tidak jelas mengenai penciptaan lukisan tersebut. Keraguan juga timbul sama ada lukisan tersebut adalah original.

(2) Plaintif juga tidak menunjukkan bahawa caragaya tayar itu adalah tersendiri kepada mereka dan bahawa orang awam akan mengenali tayar itu melalui caragaya dan bukan namanya. Oleh kerana semua tayar dicetak dengan cap nama dan nama tayar, sebarang kekeliruan tidak akan timbul kerana pelanggan, pada praktisnya, akan memilih cap dahulu sebelum membuat keputusan jenis tayar yang dikehendaki.

(3) Oleh kerana tayar Aquatred berada di pasaran Malaysia hanya untuk lapan bulan apabila tindakan ini dibawa, tempoh ini terlalu pendek untuk mewujudkan nama baik dan reputasi.

(4) Walaupun terdapat suatu soalan serius yang perlu dibicarakan, imbangan kemudahan memihak kepada defendan. Jika injunksi diberikan, plaintif akan memperolehi suatu monopoli yang tidak saksama dalam pasaran tayar untuk rekabentuk 'aqua' tersebut.]

[*Editorial Note*: The plaintiffs have appealed to the Supreme Court vide Civil Appeal No 02–604–93.]

Notes

For cases on the infringement of trademarks, see 12 *Mallal's Digest* (4th Ed) paras 832–841.

For cases on passing-off, see 12 *Mallal's Digest* (4th Ed) paras 843–865.

Case referred to

1 *Pakai Industries Bhd v Chen Yew Industries Sdn Bhd* [1991] 2 CLJ 1574 (folld)

Porres Royan (*Michael Soo* with him) (*Shook Lin & Bok*) for the plaintiffs.
S Ambiga (*Timothy Siaw* with her) (*Skrine & Co*) for the defendant.

Abdul Malek J: The plaintiffs had, by a summons-in-chambers filed on 23 June 1993 applied for the following orders:

(1) That the defendant, whether acting by its directors, officers, servants or agents or any of them or otherwise howsoever, be restrained until further order or pending trial of this action from doing the following acts or any of them, that is to say:

(a) reproducing or substantially reproducing in any material form, possessing or selling by way of trade, distributing in the course of business, tyres known as Aquagrip tyres, being unlicensed reproductions or substantial reproductions of the first plaintiff's said drawings and/or three-dimensional tyres for which copyright subsists in favour of the first plaintiff in Malaysia of Aquatred tyres as are more specifically described in the statement of claim (hereinafter referred to as 'the first plaintiff's said drawings and three-dimensional tyres', respectively);

(b) causing, enabling or assisting others to reproduce and/or dispose of unlawfully, without the consent or licence of the first plaintiff in any material form by possessing, or selling by way of trade, distributing in the course of trade, tyres known as Aquagrip tyres, being unlicensed reproductions or substantial reproductions of the first plaintiff's said drawings and/or three-dimensional tyres of Aquatred tyres for which copyright subsists in favour of the first plaintiff in Malaysia;

(c) converting to and for its own use and purpose, the first plaintiff's drawings and/or three-dimensional tyres of Aquatred tyres for which copyright subsists in favour of the first plaintiff in Malaysia in any material form by possessing, or selling by way of trade, distributing in the course of trade, tyres known as Aquagrip tyres, being unlicensed reproductions or substantial reproductions of the first plaintiff's said drawings and/or three-dimensional tyres of Aquatred tyres;

(d) exposing or offering for sale tyres known as Aquagrip tyres, being unlicensed reproductions or substantial reproductions of the first plaintiff's said drawings and/or three-dimensional tyres of Aquatred tyres;

(e) passing-off or attempting to pass off or causing, enabling or assisting others to pass off tyres not the tyres of the plaintiffs as and for the tyres of the plaintiffs or as indicating a connection or association with the plaintiffs by the use or purported use or in connection therewith in the course of trade, the get up comprising of the tread design and/or other

features which are colourably, confusingly or deceptively similar to that of the plaintiffs' Aquatred tyres; or

(f) passing-off or attempting to pass off or causing, enabling or assisting others to pass off tyres not the tyres of the plaintiffs as the tyres of the plaintiffs or as indicating a connection or association with the plaintiffs by the use or purported use or in connection therewith in the course of trade the word 'Aquagrip' or any colourable imitation thereof;

(2) that the defendant do forthwith withdraw, remove or retrieve from the market all its tyres which are reproductions or substantial reproductions of the plaintiffs' said drawings and/or three-dimensional tyres of Aquatred tyres and/or consisting of a get up comprising the tread design and/or other features which are colourably, confusingly or deceptively similar to the get up of the plaintiffs' Aquatred tyres and/or tyres bearing the word 'Aquagrip' and/or any other word or words which are colourably or confusingly similar to the word 'Aquatred';

(3) that the defendant do within seven days of the date of service of this order upon it or its solicitors, affirm and file an affidavit and serve a copy thereof upon the plaintiffs' solicitors, Messrs Shook Lin & Bok of 20th Floor, Arab-Malaysian Building, 55 Jalan Raja Chulan, 50200 Kuala Lumpur setting forth accurately and in detail:

(a) the number and quantity in term of units of Aquagrip tyres it has manufactured (including any and all manufactured on its behalf by any contract manufacturer), distributed, supplied and/or sold in Malaysia;

(b) the names and addresses of all persons, firms and companies to whom the defendant has sold or distributed or intends to sell and distribute its Aquagrip tyres; and

(c) the quality and cost of its tyres sold and distributed by the defendant until the terms of the service of the order herein;

and do exhibit thereto all relevant contracts, invoices, order forms and all other documents or copies thereof in the defendant's or its agents' possession, power, custody or control and confirm that the transactions therein appearing refer to the Aquagrip tyres;

(4) that the costs of and incidental to this application be paid by the defendant to the plaintiffs; and

(5) such further or other relief as this honourable court may deem fit.

It is the plaintiffs' case that being an established leader of, and one of the largest tyre manufacturers and sellers in the world, their team of experts had, in April 1990, designed and invented a revolutionary tyre known as Aquatred. As such, they maintain that they are the copyright owner of the two-dimensional and three-dimensional drawings of Aquatred tyres and are eligible for protection under the Copyright Act 1987 (hereinafter 'the Act') by virtue of Malaysia's accession to the Berne Convention for the Protection of Literary and Artistic Works 1886 (hereinafter 'the Berne Convention').

On 20 November 1990, the first plaintiff had filed a Patent Design Application No 616,298 for an invention entitled 'Pneumatic Tire Tread and Buttress' in the United States of America (hereinafter 'the United States') and on 22 September 1992, US Patent Design No 329,627 was granted to the first plaintiff. On 8 March 1991, the first plaintiff had filed

a Patent Application No 666,329 for an invention entitled 'Pneumatic Tire having a Unique Footprint' in the United States in respect of the Aquatred tyre and on 5 January 1993, US Patent No 5,176,766 was granted to the first plaintiff.

In or about October 1991, the first plaintiff had manufactured, distributed and sold Aquatred tyres reproduced from the two-dimensional drawings in the United States and, for the period from October 1991 to June 1993, more than a million Aquatred tyres had been sold in the United States. In the process, the first plaintiff had expended more than US$30m for advertising and promoting the Aquatred tyres in the United States and more than RM1m had been expended for similar purposes in Malaysia. Before they were commercially launched in the United States, Malaysia, Europe and other countries, the first plaintiff had expended about US$4.15m in research and development. The Aquatred tyres had proved to be a tremendous success in the United States and Malaysia.

As at April 1993, the first plaintiff had manufactured and sold more than 46,000 Aquatred tyres in Europe. Earlier, in October 1992, the Aquatred tyres were imported and about 2,000 were sold in Malaysia by the second plaintiff. The launch and sales had been widely publicized. The plaintiffs contend that the Aquatred tyres have a unique and distinctive get up, namely, the centre groove which had won or been awarded a number of awards for being a revolutionary and breakthrough product of the first of its kind in the tyre industry around the world.

The plaintiffs claim that in April 1993, the defendant had launched and sold Aquagrip tyres which were a reproduction or a substantial reproduction of the two-dimensional drawings of the Aquagrip tyres which constitute an infringement of copyright in the plaintiffs' dimensional drawings and tyres and passing-off its Aquagrip tyres as and for Aquatred tyres.

Learned counsel for the plaintiffs had argued that their two-dimensional drawings are artistic works eligible for protection under the Act and that the employees of the first plaintiff had expended sufficient skill, time and effort in making the drawings original in character. He had further submitted that the artist of the drawings entitled to protection under the Act is the author in whom the copyright is conferred and where the work is made in the course of the author's employment, the copyright is deemed to be assigned to the author's employer, and unless there is express agreement to the contrary, the first plaintiff is the owner of the copyright. The test of originality, he had continued, is whether the author had put in sufficient effort and time in creating the work and the law does not demand original or inventive thought as it suffices if it has not been copied from someone else.

Learned counsel had reiterated that to allege that the plaintiffs had copied the Aquatred tyre tread design from someone else is untenable as the first plaintiff had designed a tyre with a centre channel similar to the Aquatred tyre tread design as early as in 1982. He had alleged that the defendant's Aquagrip tyres are a reproduction or a substantial reproduction of the plaintiffs' drawings or were reproduced from the Aquatred tyres by way of reverse engineering. He further stated that since the plaintiffs had

A acquired a substantial degree of reputation and goodwill in the Aquatred tyre in that its get up is distinctive of the plaintiffs by reason of extensive use, sales and promotion in the United States and Malaysia, the plaintiffs had shown a valid cause of action for passing-off. His view was that there is a serious question to be tried, the balance of convenience lies in favour of the plaintiffs and damages are not an adequate remedy for copyright infringement.

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Learned counsel for the defendant had replied that a patent was different from copyright as, under the law, the former protects ideas but the latter does not but only protects artistic work which has to be original. She submitted that the plaintiffs were seeking to protect the function of tyres as opposed to artistic work but all the time, money and effort put in were for the principles of the function of the tyre and not the artistic work. As such, her view was that the plaintiffs had not established all the legal requirements for copyright protection. There was also no evidence, she added, as to who the author was, as the work would only subsist during the life of the author plus 50 years, and there was no contract of employment to show that it was done in the course of employment nor any evidence as to which drawing came first.

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Having considered the affidavits, arguments and authorities and having studied the relevant drawings and examined the samples of the actual tyres involved, I had come to the conclusion that this was not a proper case to grant the injunction as applied for by the plaintiffs. I had accordingly dismissed their application with costs.

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To support this finding, it is relevant to reproduce some excerpts from *Copinger and Skone James on Copyright* (13th Ed, 1991). The first at p 1 reads:

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> Copyright law is concerned, in essence, with the negative right of preventing the copying of physical material. It is not concerned with the reproduction of ideas, but with the reproduction of the form in which ideas are expressed. Originally copyright law was concerned with the field of literature and the arts but, in seeking, in particular, to keep up with advances in technology, the protection given by copyright law has been considerably expanded over the years. Thus, today, not only is protection given to literary, dramatic, musical and artistic works (with, for instance, computer programs being protected as literary works), but also to sound recordings, films, broadcasts, cable programmes and the typographical arrangement of published editions. Copyright is a property right, but one result of this expansion in protection is that, whereas this branch of the law used to be described by all as 'intellectual property,' it is now described, by some, as 'industrial property.'
>
> Copyright is not a monopoly, unlike patents and registered designs, which are. Thus, if it can be shown that two precisely similar works were in fact produced wholly independently of one another, there can be no infringement of copyright by one of the other.

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I The second at p 30 states:

> Ideas, however original, are not protected by copyright. Consequently, where a very simple diagram embodies an original idea, it is the diagram and not the idea which is protected. In such a case the protection afforded by copyright is

relatively weak, as exemplified by the case of *Kenrick & Co v Lawrence & Co* (1890) 25 QBD 99. In that case the plaintiff conceived the idea of printing and publishing cards bearing a representation of a hand holding a pencil in the act of completing a cross within a square, with a view to such cards being used at elections by illiterate voters. The plaintiff procured an artist to make, under his directions, a drawing of the representation. Subsequently the defendants published similar cards with a hand holding a pencil, but the hand in the defendants' cards was in a slightly different position, though the idea was clearly taken from the plaintiff's cards. It was held that the defendants had not infringed the plaintiff's copyright. There was no copyright in the idea; the defendants' work was not an exact reproduction of the plaintiff's, and the plaintiff was not entitled to prevent anyone from producing such a simple design as a hand in a square in any form.

The third at pp 58 and 59 says:

Copyright protection is given to literary, dramatic, musical and artistic works and not to ideas, and therefore it is original skill or labour in execution of the work, and not originality of thought, which is required. The word 'original' does not, in this connection, mean that the work must be the expression of original or inventive thought; the originality required relates to the expression of the thought. The position in this respect under the Copyright Acts may be contrasted with the standard required for registered designs under the Registered Designs Act 1949. The requirement for registration under that Act is of novelty, so that, if a design in fact resembles an existing design, it may not be registered, even though the designer of the second design arrived at this design entirely independently of the first design.

... What the Copyright Acts require is that the work should originate from the author; it must not be copied from another work, for a mere copyist does not obtain copyright in his copy. This is the true meaning of 'original'. A work may be 'original' in this sense, even though the author has drawn on knowledge common to himself and others, or has used already existing material.

... Despite the fact that the copying, even in the same medium, of an artistic work, requires a higher degree of skill and judgment than the mere reproduction of a literary work, it has been stated that skill, labour and judgment merely in the process of copying cannot confer originality and the mere copyist cannot have protection for his copy. Particularly, therefore, where the reproduction is in the same medium as the original, there must be more than an exact reproduction to secure copyright; there must be some element of material alteration or embellishment which suffices to make the totality of the work an original work. If the original, in the case of a painting, is used merely as a model to give the idea of the new work or, in the case of a photograph, merely as a basis to be worked up by photographic process to something different, then the new work may be entitled to protection; but, if the result is simply a slavish copy, it will not be protected. Thus, where the work was traced from an existing shape, that was held not to involve sufficient skill and labour to create an original artistic work.

It is my view that what the plaintiffs are in essence asking to protect is the idea of the function of the tyre and not its artistic value. As for the idea, it only relates to the principle on which the tyre functions. As for the authorship, it is not clear who was or were the artists of the drawings, whether he or they were qualified, when the drawings were done, to determine whether the copyright still subsists, and whether the artist or artists was or were employed or contracted by the plaintiffs to do the drawings. There is also no clear evidence as to whether the drawings are original. On the contrary, there is

A evidence that Continental Tyres in the United States had come up with a similar idea at an earlier stage. As for the expert's report which was served fairly late thus not enabling the defendant to come up with their own expert's report, the so-called plaintiff's expert is actually a forensic expert and not a tyre tread design expert.

B With regard to passing-off, the plaintiffs have not shown that the get up is distinctive of the plaintiffs' to the exclusion of all others and that the public would recognize the tyre by its get up and not its name. Goodwill and reputation would also depend on the period the tyres had been in the Malaysian market, the longer it is, of course, the better but since the plaintiffs had launched Aquatred only in October 1992 and their writ of C summons had been filed on 23 June 1993, the period is a very short eight months, too short in the court's opinion to establish any goodwill and reputation. None of the five requirements contained in *Pakai Industries Bhd v Chen Yew Industries Sdn Bhd*,[1] namely:

(1) a misrepresentation;
D (2) made by a trader in the course of trade;
(3) to prospective customers of his or ultimate consumers of goods or services supplied by him;
(4) which is calculated to injure the business or goodwill of another trade; and
(5) which causes actual damage to a business or goodwill of the trader by E whom the action is brought

have been proved in this case.

What is important, however, is that in practice, when a customer wishes to purchase a tyre, whether or not with the central groove aqua design, he would normally ask for it by brand name, and if he wanted the tyre with the F aqua design, he would of course quote the relevant name. The court takes judicial notice that for all tyres, similar to the samples produced, both the brand name and the tyre name would be clearly imprinted on the tyres and no confusion would therefore arise as the customer would have chosen the brand first before deciding on the type of tyre he wants. With both the G brand names and the tyre names on the tyres, a customer could hardly be confused by any similarity, if any, in the tread design. There is also no evidence that any one had been so confused. To grant the injunction would certainly give the plaintiffs an unfair monopoly of the tyre market for the aqua design.

It is also my view that the matter would be more properly dealt with at H a full trial instead of merely on contentious affidavit evidence and an early trial, of course, would be more appropriate than the grant of the injunction to the plaintiffs pending the trial. As stated earlier, the plaintiffs' application is dismissed with costs as, although there is a serious question to be tried, the balance of convenience lies in favour of the defendant.

I *Application dismissed.*

Reported by Tay Pek San